

**REMARKS**

Claims 1-22 have been examined. With this amendment, Applicant cancels claim 17.

Claims 1-16 and 18-22 are all the claims pending in the application.

**1. Claim Rejections under §102**

The Examiner has rejected claims 1-5, 10, 12, 14, 17 and 20 under 35 U.S.C. § 102(b) as being anticipated by Chi et al. (U.S. Patent No. 5,121,258) [“Chi”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a method of magnetic transfer by conveying a slave medium with a “recording surface of the slave medium [that] faces vertically toward the master carrier, being held in a manner that an information-bearing surface thereof is held vertically.” The Examiner contends that Chi discloses these features. Specifically, the Examiner contends that Fig. 2 and col. 2, lines 46-52, col. 5, lines 22-32 and col. 6, lines 62-66, disclose the claimed vertical arrangement of the slave medium (Office Action at page 2).

Applicant submits that the description of Chi does not provide any disclosure or suggestion that the orientation of the slave surfaces 54, 58 “faces vertically toward the master carrier, being held in a manner that an information-bearing surface thereof is held vertically” as set forth in claim 1. It appears that the sole basis for the Examiner’s contention that the slave surfaces 54, 58 are oriented vertically is the illustrations of the system in Figs. 1 and 2. However, Applicant submits that “reading into” the figures a vertical orientation for the slave and master surfaces is improper since there is no indication of vertical orientation in the figures, and the text of Chi is silent on the orientation of the master and slave surfaces.

The Examiner uses col. 6, lines 62-66, of Chi to support his contention that the claimed vertical orientation of the slave and master surfaces are disclosed. However, this section of Chi actually discloses that the electromagnet “pole tips [which have a magnetic transfer field extending axially between them] effects a pattern of vertical magnetization on the slave disk.” Applicant submits that any reliance on the term “vertical” in vertical magnetization is misplaced since there is no correlation with “vertical magnetization” of a disk and the orientation of the disk itself.

Because the Examiner has not shown that Chi discloses or suggests all the elements of claim 1 as is required for a rejection under §102, Applicant requests that the Examiner withdraw the rejection of claim 1.

In addition, the Examiner, in the Advisory Action of October 18, 2004, contends that the claimed vertical orientation has no meaning without setting the axis of rotation. Claim 1 recites that a “recording surface of the slave medium faces vertically toward the master carrier, being held in a manner that an information-bearing surface thereof is held vertically.” (emphasis added).

Applicant submits that the meaning of “vertical” as recited in claim 1 would be understandable to one skilled in the art since claim 1 clearly conveys that the vertical orientation is with respect to the recording and information-bearing surfaces of the slave medium and master carrier, respectively.

However, to further prosecution of this case, Applicant has incorporated the subject matter of claim 17 such that the orientation of the slave and master surfaces has been further defined with respect to ground.

Because claim 4 recites features similar to those given above with respect to claim 1, Applicant submits that claim 4 is patentable for at least reasons similar to those given above with respect to claim 1.

With respect to claims 2 and 5, Applicant incorporates the arguments submitted in the filings of January 15, 2004, and July 6, 2004, in their entirety.

In addition, claim 2 recites that “wherein, after the slave medium is disposed on the slave holder, the slave holder is conveyed to the master carrier.” Even assuming, for the sake of argument alone, that spindle 24 of Chi corresponded to the claimed slave holder, Chi discloses that after the slave diskette is mounted on spindle 24, member 30, which holds the master carrier, is moved until pole pieces 18, 32 clamp the slave diskette (col. 4, lines 4-16). There is no disclosure or suggestion in Chi that, after the slave diskette is mounted on spindle 24 that the spindle 24 is conveyed towards a master carrier.

Accordingly, Chi does not disclose or suggest that “after the slave medium is disposed on the slave holder, the slave holder is conveyed to the master carrier” as set forth in claim 2. Therefore, Chi does not disclose or suggest all the elements of claim 2 as is required for a rejection under §102.

Because claim 5 recites features similar to those given above with respect to claim 2, Applicant submits that claim 5 is patentable for at least reasons similar to those given above with respect to claim 2.

Applicant submits that claims 3, 10, 12, 14 and 20 are patentable at least by virtue of their respective dependencies.

In addition, claim 12 recites “generating a transfer magnetic field at at least one side of the slave medium wherein the transfer magnetic field is applied in a direction parallel to a tracking direction of the slave medium.” The Examiner contends that the generation of a magnetic transfer field between pole pieces 18, 32 correspond to this feature.

Chi discloses that a single closed-loop flux-conducting path for the transfer field extends between pole pieces 18, 32 of electromagnet 11 (see col. 3, lines 53-55 and col. 5, lines 36-40). This direction of the transfer magnet field is the same as the slave’s easy axis (col. 3, lines 2-3). The slave’s easy axes 55 are orthogonal to the slave’s surfaces 54, 58 (col. 5, lines 32-34). Accordingly, Chi discloses a transfer magnetic field that is perpendicular to the surface of the slave medium.

Applicant submits that one skilled in the art would know that the “tracking direction” of a disk refers to a path that is parallel to the surface of the disk. Accordingly, Chi does not disclose or suggest “generating a transfer magnetic field at at least one side of the slave medium wherein the transfer magnetic field is applied in a direction parallel to a tracking direction of the slave medium” as set forth in claim 12.

Because claim 14 recites a feature similar to that given above with respect to claim 12, Applicant submits that claim 14 is also patentable for at least the additional reason given above with respect to claim 12.

**2. Claim Rejections Under §103**

The Examiner has rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Chi in view of Bonyhard (U.S. Patent No. 6,181,492) [“Bonyhard”]. For at least the following reasons, Applicant traverses the rejection.

Because Bonyhard does not cure the deficient teachings of Chi given above with respect to claims 1 and 4, Applicants submit that claims 8 and 9 are patentable at least by virtue of their respective dependencies.

The Examiner has rejected claims 6, 7, 11, 13, 15, 16, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Chi in view of Ishida et al. (U.S. Patent No. 6,347,016) [“Ishida”]. For at least the following reasons, Applicant traverses the rejection.

Because Ishida does not cure the deficient teachings given above with respect to claims 1, 2 and 5, Applicant submits that these claims are patentable at least by virtue of their respective dependencies.

In addition, with respect to claims 6, 7, 11, 13, 15 and 16, the Examiner concedes that the subject matter of these claims is not disclosed in Chi but applies Ishida to allegedly cure the deficiency. The Examiner contends that one skilled in the art would have combined the references to ensure uniform contact between the master carrier and the slave disk.

Applicant submits that the mere “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP at 2100-131, See also *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (“While [an] apparatus may be capable of being modified ... [as] claimed, there must be a suggestion or motivation in the reference to do so.”).

Here, Ishida looks to solve the problem of a possible insecure contact at the periphery of the master carrier/slave disk interface by providing additional flange plates 203 and 204 that are bolted around the master carrier and slave disk. An insecure contact may be formed because the vacuum to hold the master carrier and slave disk may be weak at the periphery. See col. 29, lines 25-52).

Chi discloses that member 30 is advanced until pole tips 18, 32, which carry the master carriers, clamp the slave disk (col. 4, lines 10-26, Fig. 2). Chi does not use a vacuum system when clamping the slave disk. Accordingly, the problems with the vacuum system of Ishida do not exist with the clamping system of Chi.

In addition, there is no disclosure or suggestion in either Chi or Ishida that the clamping system of Chi has problems related to insecure contact at the periphery. Absent such a suggestion, Applicant submits that the prior art does not suggest to one skilled in the art the desirability of making the modification as suggested by the Examiner. Accordingly, the

Examiner's proffered reason is not supported in the prior art, and the Examiner has failed to make a *prima facie* of obviousness.

The Examiner also concedes that the subject of claims 21 and 22 are not disclosed by Chi but applies Ishida to allegedly cure the deficiency. The Examiner contends that one skilled in the art would have been motivated to modify the transfer magnetic field of Chi, which is orthogonally oriented with respect to the slave disk surface, to the magnetic transfer system of Ishida, which is parallel to the surface of the slave medium, in order "to ensure a uniform contact between the master carrier and the slave disk." Office Action at page 8.

Applicant submits that the orientation of the transfer magnetic field is unrelated to the contact interface uniformity between the master carrier and the slave disk. Accordingly, the Examiner's proffered reason for combining the references is not supported in the prior art.

In addition, to modify the system in Chi to enable a transfer magnetic field that is parallel to the slave medium surface would require that additional electromagnets be installed in order to transfer information from the master carriers to both sides of the slave disk. Chi specifically discloses that its invention solves problems of the prior art that require two electromagnetics by providing a single electromagnet (see col. 2, lines 14-52).

Accordingly, the Examiner's suggested modification would change the principle of operation of the system in Chi. Therefore, Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness. See MPEP 2100-132 (Proposed modification cannot change the principle of operation of a reference.).

**3. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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